

REMARKS

The Applicants have carefully studied the outstanding Office Action. The present response is intended to be fully responsive to the rejection raised by the Office and is believed to place the application in condition for allowance. Further, the Applicants do not acquiesce to any of the Office's rejections not particularly addressed. Favorable reconsideration and allowance of the application is respectfully requested.

Claim Status

The application as filed included 54 claims. However, claims 1-12 and 42-51 are canceled in light of a restriction requirement, thereby leaving claim 13-41 and 52-54 still under examination.

Of these, claims 13, 27 and 52-54 are in independent format. Claims 14-26 ultimately depend from claim 13, and claims 28-41 ultimately depend from claim 27. Each of the dependent claims necessarily includes all the elements from the base claims and any intervening claims.

The Office rejected claims 13-14, 22, 25-26 and 52 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,956,487 granted to Venkatraman et al. ("Venkatraman"). The Office also rejected claims 17, and 23-24 under 35 U.S.C. § 103(a) as being unpatentable over Venkatraman in view of the Office's Official Notice. The Office rejected claims 15-16, 18-20, 27-35, 37, 39-41 and 53-54 under 35 U.S.C. § 103(a) as being unpatentable over Venkatraman in view of the U.S. Patent No. 6,587,125 granted to Paroz ("Paroz"). The Office rejected claims 38 under 35 U.S.C. § 103(a) as being

unpatentable over *Venkatraman* in view of *Paroz* and in further view of the Office's Official Notice. The Office rejected claims 21 and 36 under 35 U.S.C. § 103(a) as being unpatentable over *Venkatraman* in view of *Paroz* and in further view of U.S. Patent Application Publication No. 2003/0217360 filed by Gordon et al. ("*Gordon*").

Discussion of Amendments

The independent claims 13, 27, and 52-54 have been amended to clarify that the server that operates the Web-hosted application is remote from the media device.

In the disclosure of *Venkatraman*, Web server functionality is "embedded in" a device (see Abstract). *Venkatraman* does not disclose any Web-hosted application that is remote from the media device. Because *Venkatraman* discloses only server functionality that is embedded in a device, each server of *Venkatraman* is associated with only one device. Indeed, to operate multiple devices over a network in the scheme of *Venkatraman*, each device is provided with its own server. (See Figs. 2, 4 and accompanying text.) The claimed inventions, on the other hand, by using a server remote from the device, open up the possibility of providing remote-control to multiple devices with a single server.

For these reasons, the independent claims of the application, and the claims dependent therefrom, are distinguishable over *Venkatraman* alone, and in combination with the other cited references. The pending claims are further distinguishable over the prior art of record for the reasons that follow.

Response to Section 102 Rejection

The Applicants respectfully submit that claims 13-14, 22, 25-26 and 52 are not anticipated by *Venkatraman* because such reference does not show, describe or disclose, explicitly or inherently, the combination of elements of independent claims 13 and 52. To this end, the Applicants submit that the Office has impermissibly ignored claim terms, and thus, has not appreciated the invention as claimed. Without such appreciation, the Office cited *Venkatraman*, which on its face does not teach or suggest, explicitly or inherently, all of the claimed elements, but also specifically states that it does not teach at least one of the claimed elements.

For example, the Office cited to *Venkatraman* for the proposition that it teaches all of the elements of the claims 13-14, 22, 25-26 and 52, including the claimed language of independent claims 13 and 52 directed to the integrated presentations. As set forth in the claims 13 and 52, each of the integrated presentations includes data extracted from a media device to replicate a corresponding interface of the media device. Contrary to the Office's assertions, however, the Applicants submit that *Venkatraman* does not teach any such integrated presentation.

To this end, the Applicants note that (i) the Background section of *Venkatraman* points out some of the disadvantages of native user-interface mechanisms of media devices, and (ii) the Summary of Invention section of *Venkatraman* states that it provides a web-based user interface mechanism *in lieu of* and not in addition to such a native user-interface mechanism. For instance, the Background section of *Venkatraman* states:

"The user-interface mechanisms of such devices commonly include relatively simple and low cost user input and display mechanisms. Such simple mechanisms may include, for example, light emitting elements such as

LED/LCD elements as well as various types of simple input buttons or switches. Such simple mechanisms are typically constructed to be low cost to minimize the overall cost of such devices. In addition, such mechanisms are usually compact and enable relatively small sizes for such devices. Unfortunately, such simple user interface mechanisms severely limit the range and flexibility of the user interface functions provided by such devices.

The user-interface functions of such a device may be enhanced by the implementation of a screen-based user interface mechanism within the device. For example, such a device may include a display screen, and a rendering processor along with appropriate software for generating a rich graphical user interface suitable for the particular type of device. However, such screen displays and rendering mechanisms are usually expensive and increase the overall cost of the device. Such high costs are typically unsuitable for lower cost devices targeted for a relatively large mass market. Moreover, display screens and associated hardware may be too bulky for the size constraints of many devices.

A screen-based user interface may be provided for a device using an external computer system. For example, the device may be connected to the computer system through either a standard connection such as a serial or parallel port connection or through a specialized hardware interface. The external computer system usually executes a set of software for communication and user interface to the device. The external computer system may implement a screen-based user interface for the device. The external computer system may also execute web server software that enables external web browsers to access the computer system and in turn the user interface of the device.

Unfortunately, such an external computer system greatly increases the cost of providing a screen-base user interface for a device. In addition, such prior computer system based solutions usually require the development of specialized software for each particular type of device. Moreover, such specialized software for a particular device from a particular manufacturer must typically be developed for differing types of computer system platforms. Such a variety of differing software for differing platforms greatly complicates the task of providing support for the devices. Furthermore, the development and support costs of such a variety of software usually increase the overall cost of providing a screen based user interface for such devices” (emphasis added). Venkatraman at col. 1, line 28 to col. 2, line 10.

The Summary of Invention of *Venkatraman* states:

“A solution for providing widely accessible, low cost, and enhanced user interface functions for a device is disclosed. The solution involves embedding web access functionality into the device including a web server that provides

a device web page. The device includes an embedded network interface that enables access to the device web page by a web browser. A user of the web browser accesses the user interface functions for the device through the device web page. The web server functionality may be implemented with existing circuitry in a device, such as an exiting processor, memory, and input/output circuitry that normally perform device-specific functions, thereby avoiding the extra cost and space required for dedicated web server hardware for the device.

The web server functionality embedded in the device enables device user interface access via a variety of communication mechanisms including the world wide web portion of the Internet. The costs of providing screen based user interface mechanisms are exported away from the device and do not require an external computer to provide a device web server. The methods and mechanisms disclosed herein provide screen based user-friendly interfaces to a wide variety of devices without the necessity to develop expensive hardware and software applications for differing devices. The present methods and mechanisms employ web technology so that access to a device user interface is independent of the computer system platform employed and independent of the web browser software executed and independent of the location of the use" (emphasis added). Venkatraman, at col. 2, lines 27-37.

In view of the foregoing and the rest of the specification of *Venkatraman*, the Applicants submit that the web-based user-interface mechanism of *Venkatraman* is the only interface of the disclosed media device. And as such, the web-based user-interface mechanism does not include a native user-interface mechanism. Thus, the web-based user-interface mechanism of *Venkatraman* cannot replicate a native user-interface mechanism.

Unlike *Venkatraman*, the presently claimed invention includes elements directed to web-hosted applications that form integrated presentations that include data extracted from a media device to replicate a corresponding interface of the media device. For instance, both of the independent claims 13 and 52 recite "receiving one or more integrated presentations formed by the web-hosted application and sent by the first server in response to accessing the first server, each of the integrated presentations including the data extracted to replicate a corresponding interface of the media device."

In view of the foregoing, the Applicants submit that *Venkatraman* fails to anticipate the independent claims 13 and 52, and therefore submit that these claims are allowable. Since each of the dependent claims 14, 22, and 25-26 necessarily include the elements of the independent from which they ultimately depend, the Applicants further submit that these dependent claims are allowable for the same reasons.

Response to Rejection of Claims 17 and 23-24 under 35 U.S.C. §103(a)

As noted above, the Office rejected claims 17 and 23-24 under 35 U.S.C. §103(a) as being unpatentable over *Venkatraman* in view of the Office's Official Notice. The Office Action cited *Venkatraman* for the proposition that it teaches all of the elements of the independent claims 13, including the claimed language directed to the integrated presentations. The Office, however, took Official Notice with respect to the elements of recited in dependent claims 17 and 23-24.

With respect to claim 17, the Office stated that *Venkatraman* does not teach the claimed “web-hosted application running on a second server.” The Office then states that “the concept of a web-hosted application running on a second server is known and accepted in the art.”

With respect to claim 23, the Office states that *Venkatraman* teaches that the claimed media device as embodied as a digital video recorder, but does not teach the claimed media device being embodied as a personal digital assistant, a mobile telephone, or a pager. The Office then stated that these elements are obvious variations of the digital video recorder embodiment of the media device.

With respect to claim 24, the Office states that *Venkatraman* teaches that the interface of the media device, but does not teach the claimed interface as embodied as a login interface, a Channel Guide, a Replay Guide, Reply Shows, Replay Channels, Find Shows, and Manual Record. Like the Office's rejection of claim 23, the Office stated that these elements are obvious variations of the interface of the media device of *Venkatraman*.

Challenge of Official Notice

The Applicants respectfully challenges the taking of Official Notice with respect to each of the claims 17 and 23-24. Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection) (emphasis added).

With respect to claim 17, the Applicants disagree with the contention that the record contains specific factual findings and concrete evidence to support that it is known to teach the claimed web-hosted application running on a second server (and not any web-hosted application). In other words, the Applicants submit that *Venkatraman* fails to teach the claimed elements directed to second server running the web-hosted applications that form integrated presentations that include data extracted from a media device to replicate a corresponding interface of the media device. In fact, as pointed out above, the Applicants submit that *Venkatraman* teaches away from a first server, much less a second server,

running the claimed web-hosted applications. The Applicants invite the Office to review the cited art, and pursuant to M.P.E.P. § 2144.03, request that a supporting reference be cited.

With respect to claims 23-24, the Applicants disagree with the contention that the record contains specific factual findings and concrete evidence to support that it is known to teach the claimed media device and interface (and not any media device and interface). To this end, the Applicants submit that *Venkatraman* not only fails to teach the claimed elements directed to a media device having a native user interface, but also teaches away from such a media device and interface. Pursuant to M.P.E.P. § 2144.03, the Applicants therefore request that a supporting reference be cited.

Despite not citing references to support the rejection of claims 17 and 23-24, the Applicants submit that the Office's rejection fails to raise a required *prima facie* case of obviousness. According to M.P.E.P. § 2143, in order to establish the required *prima facie* case of obviousness of a claimed invention by applying a combination of references, the proposed combination must teach or suggest all of the elements of the claimed invention.

The Proposed Combination Does Not Teach All the Elements

The Applicants submit that the combination of *Venkatraman* and the Office's Official Notice does not teach the claimed elements directed to integrated presentations. The discussion from the above section entitled "Response to Section 102 Rejection" is incorporated herein by reference. The Applicants note that the Office's Official Notice lacks support for providing the claimed elements directed to the integrated presentations.

Given that (1) the base reference (i.e., *Venkatraman*) does not disclose explicitly or inherently the combination of claimed elements including the integrated presentations, and (2) the second reference (i.e., Office's Official Notice) likewise fails to disclose such subject

matter, the Applicants submit that these references, either alone or combined, fail to teach all the claimed elements of claims 17 and 23-24. Therefore, the Applicants respectfully submit that the Office has failed to raise a *prima facie* case of obviousness. Accordingly, the Applicants submit that that the claims 17 and 23-24 are allowable.

Response to Rejection of Claims 15-16, 18-20, 27-35, 37-41 and 53-54 under 35

U.S.C. § 103(a)

According to M.P.E.P. § 2143, in order to establish the required *prima facie* case of obviousness of a claimed invention by applying a combination of references, (1) the proposed combination must teach or suggest all of the elements of the claimed invention, (2) the references must expressly or impliedly suggest the claimed invention, and (3) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

The Proposed Combination Does Not Teach All the Elements of Claims

The Applicants submit that the combination of *Venkatraman* and *Paroz* fails to teach the claimed elements of the original independent claim 13 and amended independent claims 27, 53 and 54 directed to the integrated presentations. The discussion from the above section entitled "Response to Section 102 Rejection" is incorporated herein by reference with respect to failing to teach the claimed elements of the claims 15-16 and 18-20, which depend from independent claim 13.

In addition, the Applicants submit that *Venkatraman* fails to teach for the same reason as noted above the claimed elements of the amended independent claims 27 and 53-54

directed to an integrated presentation that simulates a corresponding interface of a media device. Further, the Applicants note that the Office has not cited *Paroz* for the proposition that it teaches the claimed elements directed to an integrated presentation that simulates or replicates a corresponding interface of a media device. To this end, the Applicants submit that *Paroz* is entirely silent with respect to media devices, and therefore does not teach or suggest the claimed integrated presentations.

Given that *Venkatraman* does not disclose explicitly or inherently the combination of claimed elements, including the integrated presentations, and that *Paroz* does not disclose such subject matter, the Applicants respectfully submit that the Office has failed to raise a *prima facie* case of obviousness with respect to the claims 15-16, 18-20, 27 and 53-54. Accordingly, the Applicants submit that the claims 15-16, 18-20, 27 and 53-54 are allowable.

In addition, each of the claims 28-35 and 37-41 that depend from independent claim 27 necessarily includes the elements of claim 27. In the rejection of these dependent claims, the Office cited only *Venkatraman* (and not *Paroz*) for the proposition that it teaches the elements of the independent claim 27 directed to the claimed integrated presentations. Therefore, the Applicants submit that the Office has failed to raise a *prima facie* case of obviousness with respect to the claims 28-35 and 37-41, and therefore submit these claims are allowable.

The References Must Expressly or Impliedly Suggest the Claimed Invention

In addition to not teaching all of the elements, the Applicants submit that *Venkatraman* and *Paroz*, alone or combined, fail to expressly or impliedly suggest the claimed invention of claims 15-16, 18-20, 27-35, 37-41 and 53-54 as a whole. The

Applicants incorporate the arguments presented under the heading “Response to Section 102 Rejection.”

Unlike *Venkatraman* and the present invention, *Paroz* is directed to a method and system for remote control of a first computing device by a second computing device over a network, such as the Internet. For instance, the Abstract of *Paroz* states:

“[d]isclosed is a method for remotely controlling a first computing device from at least one of a plurality of second computing devices, the first computing device having a user interface and a data communications connection to the second computing device and the second computing device adapted to present a user interface. The method comprises analyzing the static and dynamic logic of the first computing device's user interface and creating a logically equivalent user interface in a platform-independent format for the second computing device. The equivalent user interface enables control of the first coupling device from the second computing device.”

As can be readily discerned, *Paroz* teaches a second computing device that includes a logically equivalent replication of a user interface of a first computing device. Contrary to *Paroz*, however, *Venkatraman* describes a web-based user interface of a media device that is to be used *in lieu of* a native user interface, and therefore the web-based user interface does not replicate or simulate any native user interface.

As such, *Venkatraman* teaches away from the system and method in *Paroz*, as well as the presently claimed invention. And because of the divergent teachings of *Venkatraman* and *Paroz*, such references should not be combined, nor would any combination of the references morph into the claimed invention. Thus, the Applicants submit that even if the *Venkatraman* and *Paroz* could be combined, the combination fails to teach what the Applicants have done.

The Applicants also note that the Office states that *Venkatraman* does not teach the claimed elements of claims 15 and 16 directed to object interfaces for operating the media

device. Instead of the Office relies on *Paroz* for such teaching. Regardless of whether *Paroz* teaches such elements¹, the Applicants submit that *Venkatraman* explicitly teaches away from such object interfaces. See *Venkatraman* at col. 2, lines 47-50 (stating the present techniques avoid the need of an industry-wide Application Programming Interface (API) to unify the control and use of equipment”).

In view of the foregoing, the Applicants submit that the Office has failed to make a *prima facie* case of obviousness. Therefore, the Applicants submit that claims 15-16, 18-20, 27-35, 37-41 and 53-54 are allowable.

Failure to Provide an Objective Reason to Combine References

In addition to the other requirements, in order to establish the required *prima facie* case of obviousness of a claimed invention by applying a combination of references, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01.

With respect to claims 15-16, 18-20, 27-35, 37-41 and 53-54, the Applicants respectfully submit that there is no suggestion or desirability to combine the system and method of *Venkatraman* with the system and method of *Paroz*. To this end, the Applicants direct the Office to the Background and Summary of Invention of *Venkatraman* (reproduced above, in part), which provides some objective reasons of the undesirability of replicating and/or simulating a native user interface mechanisms, such as described in *Paroz*. As such,

¹ Given that *Paroz* is entirely silent to media devices, the Applicants submit that *Paroz* does not teach claimed elements of claims 15 and 16 directed to object interfaces for operating the media device.

the Applicants respectfully submit that one skilled in the art would not combine the system of *Venkatraman* with the system and method of *Paroz* to do what the Applicants have done.

Thus, the Applicants respectfully submit that the Office has not provided a reference or statement showing some suggestion of the desirability to combine the teachings of *Venkatraman* and *Paroz* to achieve the combination of elements of claims 15-16, 18-20, 27-35, 37-41 and 53-54. Because of the absence of any evidence of a motivating force, the Applicants submit that the Office has failed to meet the initial burden of providing a *prima facie* case of obviousness. In light of the foregoing, the Applicants submit that the combination of *Venkatraman* and *Paroz* fails to render claims 15-16, 18-20, 27-35, 37-41 and 53-54 obvious. And thus, the Applicants request the Office pass these claims to issue.

Response to Rejection of Claim 38 under 35 U.S.C. §103(a)

As noted above, the Office rejected claims 38 under 35 U.S.C. §103(a) as being unpatentable over *Venkatraman* in view of *Paroz* and in further view of the Office's Official Notice. The Office Action cited *Venkatraman* and *Paroz* for the proposition that they teach all of the elements of the independent claims 27, including the claimed language directed to the integrated presentations. The Office, however, took Official Notice with respect to the elements of the dependent claims 38.

With respect to claim 38, the Office states that *Venkatraman* and *Paroz* teaches that the interface of the media device, but does not teach the claimed interface as embodied as a login interface, a Channel Guide, a Replay Guide, Reply Shows, Replay Channels, Find Shows, and Manual Record. Like the Office's rejection of claim 23, the Office stated that these

elements are obvious variations of the interface of the media device of *Venkatraman* and *Paroz*.

Challenge of Official Notice

The Applicants respectfully challenges the taking of Official Notice with respect to the claim 38. Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection) (emphasis added).

The Applicants disagree with the contention that the record contains specific factual findings and concrete evidence to support that it is known to teach the claimed media device and interface (and not any media device and interface). To this end, the Applicants submit that the combination of *Venkatraman* and *Paroz* not only fails to teach the claimed elements directed to a media device having a native user interface, but also teaches away from such a media device and interface. Pursuant to M.P.E.P. § 2144.03, the Applicants therefore request that a supporting reference be cited.

Despite not citing references to support the rejection of the claim 38, the Applicants submit that the Office's rejection fails to raise a required *prima facie* case of obviousness. The discussion from the above section entitled "Response to Rejection of Claims 15-16, 18-20, 27-35, 37-41 and 53-54 under 35 U.S.C. § 103(a)" is incorporated herein by reference. The Applicants note that the Office's Official Notice lacks support for providing the claimed elements directed to the integrated presentations.

Given that *Venkatraman* and *Paroz* do not disclose explicitly or inherently the combination of claimed elements including the integrated presentations, and the Office's Official Notice likewise fails to disclose such subject matter, the Applicants submit that these references, either alone or combined, fail to teach all the claimed elements of the claim 38. Therefore, the Applicants respectfully submit that the Office has failed to raise a *prima facie* case of obviousness. Accordingly, the Applicants submit that that the claim 38 is allowable.

Response to Rejection of Claims 21 and 36 under 35 U.S.C. § 103(a)

The discussion from the above section entitled " Response to Rejection of Claims 15-16, 18-20, 27-35, 37-41 and 53-54 under 35 U.S.C. § 103(a)" is incorporated herein by reference. With respect to the rejection of the claims 21 and 36, the Applicants note that the Office does not cite *Gordon* for the proposition that it teaches the claimed elements directed to the integrated presentations. Despite not being cited for such proposition, the Applicants submit that *Gordon* does not disclose and is entirely silent with respect to the claimed elements directed to the integrated presentations.

Given that *Venkatraman* and *Paroz* do not disclose explicitly or inherently the combination of claimed elements including the integrated presentations, and the *Gordon* likewise fails to disclose such subject matter, the Applicants submit that these references, either alone or combined, fail to teach all the claimed elements of the dependent claims 21 and 36. Therefore, the Applicants respectfully submit that the Office has failed to raise a *prima facie* case of obviousness. Accordingly, the Applicants submit that that the dependent claims 21 and 36 are allowable.

CONCLUSION

The Applicants submit that the application is in good and proper form for allowance, and respectfully request the Office to pass this application to issue. If, in the opinion of the Office, a telephone conference would expedite the prosecution of this application, the Office is invited to call the undersigned attorney, at 312-913-2115.

Respectfully submitted,

McDONNELL BOEHNEN
HULBERT & BERGHOFF LLP

February 24, 2006

By:

A handwritten signature in black ink, appearing to read 'Jeffrey A. Steck', written over a horizontal line.

Jeffrey A. Steck

Registration No. 40,184